



CASE EL/2-22798/ACGJ 130/PCT

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Andrea DeGochis
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11/13/07
Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Group Art Unit: 1752

HIDETAKA OKA ET AL.

Examiner: C. P. Johnson

APPLICATION NO: 10/535,373

FILED: MAY 28, 2005

FOR: PHOTSENSITIVE RESIN COMPOSITION

COMPRISING A HALOGEN-FREE

COLORANT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the final rejection in the above-identified application.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets.

No fee, petition, or certification is required. The Commissioner is authorized to charge any fee due, or credit any overcharge, as a result of this Amendment to Deposit Account No. 03-1935.

A handwritten signature in black ink, appearing to read "Shiela A. Loggins". The signature is fluid and cursive, with the first name "Shiela" being more prominent.

Shiela A. Loggins
Reg. No. 56,221

PRE-APPEAL BRIEF

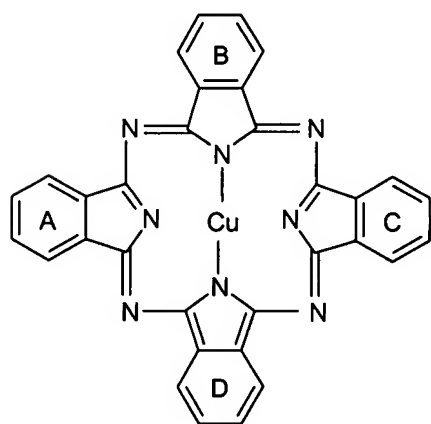
Claims 1-3, 6 and 11-13 are pending.

Claims 1-3, 6 and 11-13 are finally rejected.


Claim 1 is the only independent claim. All other claims depend therefrom.

Claim 1 reads:

1. A photosensitive resin composition comprising
as a component (A) a green colorant of the formula



(1)

in which the rings A, B, C and D are substituted by hydroxy or by the moiety $-O-(CR_1R_2)_n-$ ,

wherein R_1 is hydrogen or C_1-C_4 -Alkyl, R_2 is hydrogen or C_1-C_4 -Alkyl,

n is 0, 1, 2 or 3 and the ring E is unsubstituted or substituted by C_1-C_6 alkyl, C_1-C_6 alkoxy, hydroxy, $NHCO R_3$, $NHSO_2 R_4$ or $SO_2 NHR_5$, wherein R_3 is C_1-C_4 -Alkyl or phenyl, R_4 is C_1-C_4 -Alkyl or phenyl and R_5 is C_1-C_4 -Alkyl or phenyl,

b) as a component (B) an alkali soluble reactive or unreactive oligomer or reactive or unreactive polymer ,

c) as a component (C) a polymerizable monomer,

d) as a component (D) a photoinitiator,

e) as a component (E) an epoxy compound,

and also, if desired,

f) as a component (F) further additives.

There are two obviousness rejections which have been maintained by the examiner and made final.

These are:

1. Claims 1-3, 6 and 11-12 are rejected under 35 USC 103(a) as being unpatentable over Ushirogouchi, US 5,691,101 in view of Wolleb, US 6,087,492.

2. Claims 1 and 13 are rejected under 35 USC 103(a) as being unpatentable over Sasaki, US 4,789,620 in view of Wolleb, US 6,087,492.

Note that both rejections require Wolleb, US 6,087,492.

The examiner agrees that both Ushirogouchi and Sasaki do **not** teach the phthalocyanine of presently claimed formula (1). Thus in order for the above rejections to be valid, Wolleb must complete the suggestion for a phthalocyanine of formula (1). Applicants respectfully submit that Wolleb fails to do this.

In regard to rejection 1

The Examiner points to Ushirogouchi as teaching a photosensitive composition comprising elements b through e. In order to meet the limitations of the claims, the Examiner combines Wolleb with Ushirogouchi. As stated above the examiner believes Wolleb to define a phthalocyanine of present formula (1). The applicants believe the examiner is in error in this regard. While Wolleb does define a phthalocyanine, Wolleb does not disclose phthalocyanine encompassed by the present formula (1).

The presently claimed formula (1) requires that the rings **A,B,C and D** are substituted by **hydroxy** or by the moiety **-O-(CR1R2)_n-phenyl**.

Upon reading Wolleb description of his formula (I), the Applicants see absolutely no overlap between Wolleb and the presently claimed formula (1). The Wolleb formula (1) may be substituted by **X Y** or **Z**.

In order for Wolleb to suggest a phthalocyanine encompassing presently claimed formula 1, X, Y and Z markush groups would need to encompass **hydroxy** or the moiety **-O-(CR1R2)_n-phenyl**, a requirement of the present claims.

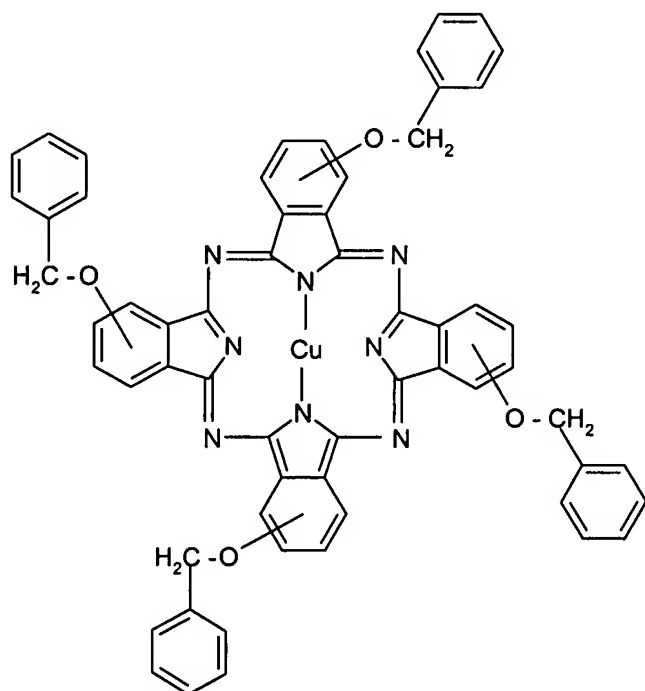
X, defined by Wolleb is **not hydroxy** or **-O-(CR1R2)_n-phenyl**. The broad definition for X can be found at the end of column 2, the last 3 lines. Z is **not hydroxy** or **-O-(CR1R2)_n-phenyl**. See col: 3, lines 2-5.

This leaves Y. Y may be R1 and R1 may be C1-C20 alkoxy (see abstract and col. 4, line 43).

Applicants respectfully point out that alkoxy is not the same as **hydroxy** or the moiety **-O-(CR1R2)n-phenyl**. **There is no suggestion in Wolleb that the alkoxy may be substituted by phenyl.**

Furthermore, not only does Wolleb fail to suggest a single substitution of any of the A,B,C and D rings with **hydroxy** or the moiety **-O-(CR1R2)n-phenyl** but most certainly never makes a suggestion that all rings A, B,C and D be substituted with **hydroxy** or the moiety **-O-(CR1R2)n-phenyl**.

The Examiner makes the statement on page 3 in her final rejection that Y is n-octyl as in instant claim 2. See col. 3, line 43 (of Wolleb). Present claim 2 reads:



This is not aliphatic alkoxy substitution disclosed by Wolleb. The above is not substituted by an n-octyl group as stated by the examiner.

Thus as Ushirogouchi does not teach the present phthalocyanine of formula (1) and Wolleb fails to make up for that deficiency, the above obviousness rejection is improper as all the limitations of the present claims are not present in the references.

In regard to rejection 2

The above argument applies in this rejection as well. Wolleb does not disclose or suggest the present formula (1). Thus there can be no obviousness by combining Saskai and Wolleb

Applicants believe Wolleb to be deficient for the reasons expressed above. Without Wolleb the obviousness rejections are incomplete and fail to suggest all the present claim limitations.

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Respectfully submitted,



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